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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/685,143
Filing Date: October 14, 2003
Appellant(s): WALKER ET AL.

Jeffrey R Ambroziak
Registration No. 47,387
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 17 September 2008 appealing from the Office action mailed 19 March 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,942,574	LeMay	9-2000
6,126,541	Fuchs	12-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-6, 21-26 and 55-56 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over LeMay et al. (U.S. 6,942,574).

3. Regarding claims 1 and 21; LeMay discloses: A method, comprising;

Determining a message; identifying a game machine; determining gaming activity associated with a player, (col. 1:7-11, col. 3:4-7 and col. 3:21-23), allowing access to the entertainment content sources based upon the player tracking information.

Determining a feature of the game machine, the feature being selected based on the gaming activity, (col. 3:20-23), the feature selectable based on the player tracking information.

Wherein the feature comprises a feature that may be activated based on a selection by the player; (col. 3:7-10), whereas the system receives input of the selection from the player.

Outputting the message to a player via the game machine, the message comprising a recommendation of the feature, (col. 3:14-19), wherein the system outputs a message advising of the various cost of the feature. Thus, either LeMay inherently includes a recommendation or it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to interpret an advise of cost as recommendations regarding the feature, one is to include that recommendations may vary according to the nature of the selected video feature, as for example the video presentation may have several different price ranges depending of the media or specific Network channel selected.

4. Regarding claims 2 and 22; LeMay discloses: wherein determining the message includes determining a status message, (col. 5:41-47).

5. Regarding claims 3 and 23; LeMay discloses: wherein determining the message includes determining an instructive message, (3:14-19).

6. Regarding claims 4 and 24; LeMay discloses: wherein determining the message includes determining a communication message, (col. 5:41-47).

7. Regarding claims 5 and 25; LeMay discloses: wherein determining the message includes determining a promotional message, (col. 2:15-29).

8. Regarding claims 6 and 26; LeMay discloses: wherein determining the message includes determining an activity-benefit offer, (col. 3:55-60).

9. Regarding claim 55; LeMay discloses a method, comprising:

Determining an occurrence of a trigger condition; identifying a message in a database of messages based on the trigger condition; identifying a game machine from among a plurality of game machines based on the message; suppressing output of the message until a second trigger condition is satisfied; and displaying the identified message in a partition on the identified game machine upon satisfaction of the second trigger condition, (col. 3:4-23), whereas the system provides game outcome presentations for one or more games, (i.e. is triggered to send updates of games that the player has selected to track) it has to track the movement of the player on the floor to deliver the messages, and the player has to pay or have enough play history to be able to receive the content (i.e. second trigger is payment).

Wherein the partition is a pop-up window, and (figure 2(item 275 and 257)).

Wherein the identified message includes a feature recommendation, (col. 3:14-19), wherein the system outputs a message advising of the various cost of the feature. Thus, either LeMay inherently includes a recommendation or it would have been obvious to one of ordinary skill in the art at the time of the appellant's invention to interpret an advise of cost as recommendations regarding the feature, one is to include that

recommendations may vary according to the nature of the selected video feature, as for example the video presentation may have several different price ranges depending of the media or specific Network channel selected.

10. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over LeMay as applied to claim 1 above, and further in view of Fuchs (US 6,126,541).

11. Regarding (US 6,126,541); Fuchs discloses a gaming machine that provides either automatically or by calling of the player a display of the best options the player can take and the probabilities of the possible winning scenarios if the player chooses one of the choices.

12. Regarding claim 56; LeMay discloses the method of claim 1 but does not discloses how the result of the selection would have been different otherwise selected. Fuchs discloses wherein the message further comprises data indicating how a result of the gaming activity would have been different if the recommended feature had been activated during the gaming activity, Fuchs (col. 6:16-39). It would be obvious to one of ordinary skill in the art at the time of the invention to incorporate the disclosure of Fuchs with the game of Lemay includes all of the player tracking features and messaging systems. This combination would yield the predictable result as to include hints and training during the game for the player's enjoyment. Fuchs already discloses the advantages of this instructing feature for the player and would make it a great message, "prize information, or advertisements of interest to the player playing the game on the gaming machine".

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 36-40 are rejected under 35 U.S.C. 102(e) as being anticipated by LeMay.

15. Regarding claims 36 and 38; LeMay discloses: A method, comprising:

Determining a message; determining a first representation of the message and a second representation of the message; outputting the first representation of the message to a first player at a game machine; and outputting the second representation of the message to a second player at a game machine, (col. 4:61-67), similar content as presented in TV format is available in WEB page format so that two players can view the same content in two different formats.

Wherein determining the first representation includes selecting a representation based upon a characteristic of the first player, and wherein determining the second representation includes selecting a representation based upon a characteristic of the second player, (col. 4:66-67), upon the player tracking information, player preferences are kept and for those more sophisticated players, the content will be sent in their preferred format.

Wherein determining the first representation includes selecting a representation based upon an indication by the first player, and wherein determining the second representation includes selecting a representation based upon an indication by the second player, (col. 3:7-10), whereas the system receives input of the selection from the player.

16. Regarding claims 37 and 39; LeMay discloses wherein the first representation is different from the second representation, (col. 4:64-67). Whereas different media are considered different representations.

17. **Regarding claim 40;** LeMay discloses a method, comprising; determining a message to be output to a player at a game machine; and suppressing output of the message, and wherein suppressing output of the message includes delaying output of the message until a trigger condition is satisfied, (col. 3:14-23), prior to outputting the message, the system holds the information till it confirms that the credits indicia is paid (trigger event), thus the message is already created and waiting for the player to satisfy a condition before sending.

(10) Response to Argument

1. Argument 2.1, regarding **claims 1 and 21**; the appellant states the LeMay neither inherently nor obviously discloses "*outputting the message to a player via the game machine, the message comprising a recommendation of the feature [of the game machine]*". The examiner traverses the appellant's opinion by citing Lemay (col. 3:13-23), "*Additionally, the method may include, a) prior to outputting the entertainment content, determining an indicia of credit amount for the selected entertainment content source, b) displaying a message on the display device notifying a player of the required indicia of credit amount and c) initiating the selected entertainment content when the required indicia of credit amount is available on the gaming machine or i) prior to receiving the selection, receiving player tracking information and ii) allowing access to the entertainment content sources based upon the player tracking information.*", emphasis added, wherein LeMay discloses recommending to the player that for the feature their is a cost attached, thus informing of the pros and cons of the feature, the choice left to the player to continue. (Recommend i.e.; to advice or counsel). Also page 17 line 22 of the appeal brief mentions "*However, LeMay is completely devoid of any description of recommending a feature of a gaming device*"; this would not be in the scope of the claim language since the claim reads "recommendation of the feature",

which is an advice regarding something about the feature. Also page 18 line 23 of the appeal brief mentions "*As noted above, the message of LeMay is displayed after the selection of the content*"; the examiner points above where the recommendation is about the feature and without selecting the feature the system would not know to advice on the price of the feature.

2. Argument 2.2, regarding **claims 2-6**; The appellant states that the limitations as follow are not taught by LeMay:

wherein determining the message includes determining a status message. (claim 2); the examiner points again to LeMay (col. 3:14-23), where prior to receiving the selection, receiving player tracking information (player status).

wherein determining the message includes determining an instructive message. (claim 3); LeMay (col. 3:14-23), wherein the message contains instructions as to provide the required indicia.

wherein determining the message includes determining a communication message. (claim 4); LeMay (col. 3:14-23), wherein the message includes a communication to the player.

wherein determining the message includes determining a promotional message. (claim 5); LeMay (col. 3:14-23 and 3:55-60), wherein the message can include advertisement.

wherein determining the message includes determining an activity benefit offer. (claim 6). LeMay (col. 3:14-23 and 3:55-60), wherein the massage can include prize information.

In addition since the examiner has concluded that the rejection to claim 1 is proper, the rejections of claims 2-6 are also consider proper.

3. Argument 2.3, regarding **claims 22-26**; the appellant's arguments are identical to the arguments presented for claims 2-6. Please refer above to argument 2.2.

4. Argument 2.4, regarding **claim 55**; the appellant states the LeMay neither inherently nor obviously discloses "*suppressing output of the message until a second trigger condition is satisfied*", the examiner points to LeMay (col. 14:30-35) where it discloses that there is a plurality of conditions wherein at least, but not limited to a single condition to be satisfied prior to displaying content. LeMay discloses for example making a wager and that the wager be of a minimum amount, (first and second triggers). In addition appellant argues that the limitations of claim 55 are tide to or based upon the second trigger and that there is no second trigger; the examiner also points to (col. 3:20-23) wherein the message or feature is withheld till (i) receiving player tracking information and then (ii) allowing access based on the player tracking information, that constitute two places col. 14 and col. 3 where two or more conditions are necessary for the content to be displayed, that is not counting with identification and privileges of the player.

5. Argument 2.5, regarding **claims 36-39**; the appellant states the LeMay does not anticipates "*determining a first representation of the message and a second representation of the message; outputting the first representation of the message to a first player at a game machine; and outputting the second representation of the message to a second player at a game machine*", where the examiner is confident that LeMay (col. 4:61-67), "*Also, the television programming entertainment content may be displayed while a player is engaged in playing a game on the gaming machine or between games. Similarly, the entertainment content may include information available on the Internet, including the World Wide Web, for more technologically sophisticated players*", explicitly discloses the message (the entertainment content), is presented in two different formats, as television programming and as Internet content, and such presentation is dependent to the characteristic of the player (sophisticated or unsophisticated), and wherein determining the representation is inherent if the system is capable of displaying the representations, the system has to determine them first.

[Characteristic; pertaining to, constituting, or indicating the character or peculiar quality of a person or thing; typical; distinctive: *Red and gold are the characteristic colors of autumn*].

6. Argument 2.6, regarding **claim 40**; the appellant states the LeMay neither teaches or suggests "*suppressing output of the message, wherein suppressing output of the message includes delaying output of the message until a trigger condition is satisfied*", the examiner point to LeMay (col. 14:30-35), "*As described above, a player predetermined condition may include actions such as depositing money into the gaming machine or making a wager on a game where the wager is above some amount. In **610,** when at least one of the predetermined conditions is satisfied, the entertainment content may be output to an output device*", where it discloses that there is a plurality of conditions wherein at least, but not limited to a single condition to be satisfied prior to displaying content, thus delaying output. The triggers mentioned are depositing money or making a wager, etc.

7. Argument 3.1, regarding **claim 56**; the appellant states that LeMay in combination of Fuchs, neither teaches or suggests "*The message further comprises data indicating how a result of the gaming activity would have been different if the recommended feature had been activated during the gaming activity*", the examiner points to Fuchs (col. 6:16-39), "*At the same time that the machine displays these game symbols **3,** which are statistically or randomly selected by the computer unit **5,** or after a call-up button **14** is activated by the player, the computing unit **5** indicates in the winning chances display **7** the chances of winning which are readily achievable if the player actually stores certain game symbols **3'** which the computer unit **5** has judged to be advantageous for the next game. In the present case, since it is a type of poker game that is being played, the computer unit **5** has suggested that two game symbols **3',** namely the two aces, should be stored and at the same time it displays the possible ways of winning the next game by obtaining five, four or three aces, and these possible ways of winning are assigned various prize values in the display fields **21.** In addition to*

*the display panels **21** indicating the amount of the attainable prizes or combinations of prizes, it is also possible to offer the player a display **20** showing the probability with which the given combinations of game symbols or the prizes are likely to be attained. For this purpose, at least one display panel **20** is arranged in the winning chances display area **7** to indicate the likelihood, expressed in percentage terms or the probability with which an indicated combination of game symbols or an offered possibility of winning can be realized*", clearly pointing out a message sent to the player about the game in progress, a message indicating prize information of interest to the player. As pointed above in the rejection of claim 56; LeMay's invention serves a method to communicate to a player that which is of interest to the player, LeMay (col. 2:26-29), "*For example, while utilizing the gaming machine, a player may receive, e-mail, stock quotes, news and that is of particular interest to the player on the gaming machine*", also LeMay (col. 3:55-60), "*Additionally, the personal message may be selected according to a player profile for the player playing the game on the gaming machine where the personal message is stock quotes, news, prize information, or advertisements of interest to the player playing the game on the gaming machine*", indicating that prize information regarding the game is already being sent to the player as part of Lemay's invention, and that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention after reading Fuchs' invention to include a more provocative format to show the possibilities one way or another of the prize information massage of LeMay. It would be within the realm of logical possibilities to combine Fuchs in Lemay and send one more type of message of interest to the players as suggested by LeMay's examples throughout the disclosure.

8. In regards to **claim 56,** the argument on page 34 line 6, "*Note that such data is backwards looking*", the examiner takes claim 55 to be a message ahead of the selection of the feature, and claim 56 is including with the message the possibilities of what will happened, since the message from claim 55 precedes the actual execution of the recommended feature.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Frank M. Leiva/
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